

**REMARKS**

In the Official Action, the Examiner required an election among three species identified as follows:

I. *Species of the embodiment disclosed on page 1, lines 5-20; in particular, the species that requires the copy mode to be switched to the facsimile mode when the input numerical value does not [belong] to the copy mode. For example, the numerical value input exceeds the display capacity.*

II. *Species of the embodiment disclosed on page 9, lines 15-20; in particular, the species that requires the copy mode not to be switched to the facsimile mode when the input numerical value does not [belong] to the copy mode and inhibits starting copying.*

III. *Species of the embodiment disclosed on page 10, lines 2-10; in particular, the species that requires the copy mode not to be switched to the facsimile mode when the input numerical value does not [belong] to the copy mode until predetermined character which is not a numerical value is inputted.*

The Examiner indicated that no claims are considered generic. Upon entry of the present paper, Applicant will have elected, with traverse, the species identified by the Examiner as Species I, comprising claims 35-36, 44 and 47-50.

Applicant respectfully traverses the above Restriction Requirement and submits that it is inappropriate for reasons as set forth herein below.

In this regard, the species identified as Species I is asserted to be disclosed on page 1, lines 5-20. This assertion is incorrect at least insofar as page 1, lines 14-20 is part of the "Description of the Related Art", and page 1,

lines 8-11 does not include disclosure directed to those features attributed to the species identified as Species I. Accordingly, Applicant requests clarification as to what basis the Examiner believes exists for his identification of the species identified as Species I.

Further, the species identified as Species II is asserted to be disclosed on page 9, lines 15-20 and the species identified as Species III is asserted to be disclosed on page 10, lines 1-20. However, the description from page 8, line 17 to page 10, line 14 is directed to the features of a single exemplary embodiment shown in Figure 3, such that the species identified as Species II and the Species identified as Species III are each directed to a common embodiment that is adequately and properly shown in a single Figure.

Further, the exemplary method shown in Figure 3 is described, at page 8, lines 17-19 as "an operation of the image recording apparatus of the above configuration". In this regard, claims 35-43 and 47-49 are directed to an apparatus and claims 44-46 and 50-52 are directed to a method. As described above, the above-noted method disclosed in the specification is directly related to an apparatus disclosed in the specification, such that there is no proper basis for the assertion that different species are disclosed in the "Description of the Related Art" and in the disclosure which describes the method shown in Figure 3.

Applicant notes that the MPEP sets forth, at section 803, "two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent... or distinct as claimed; and (B) There would be

a serious burden on the examiner if restriction is not required" (emphasis added)". See MPEP section 803 - CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS. Both of these requirements are explicitly related, by section citations, to election of species requirements.

With respect to the first requirement, the MPEP section 806.04(b) defines independent species as the alternative to related species. Further, MPEP section 806.04(f) defines independent species as those which are mutually exclusive such that the claims which read on such species do not overlap in scope. However, as described herein, the various claims of the present application do overlap in scope.

In particular, independent claim 35 is directed to a "controller which, when the copy mode is set and when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode" emphasis added. Independent claim 37 is directed to a "controller which... when the numerical value input by the panel exceeds the predetermined number of digits of the numerical value corresponding to the number of copies... maintains the copy mode". Independent claim 40 is directed to a "controller... which switches from the copy mode to the facsimile mode when the input by the panel... includes the predetermined character". Insofar as these features are not mutually exclusive, and insofar as these features can be implemented by a single embodiment shown in the specification, Applicant submits that there is no proper basis in the MPEP for requiring election between the various species identified by the Examiner. Independent claim 44

recites a method with features similar to the above-noted features of independent claim 35. Independent claim 45 recites a method with features similar to the above-noted features of independent claim 37. Independent claim 46 recites a method with features similar to the above-noted features of independent claim 40. Accordingly, the various apparatus and method claims of the present application overlap, can be attributed to a single disclosed embodiment, and are not mutually exclusive or otherwise independent as would be required for a proper Election of Species requirement.

With respect to the second requirement, the MPEP also sets forth, at section 803, that an Examiner "must provide reasons and/or examples to support conclusions". However, the Examiner has not so much as asserted the existence of a "serious burden". Moreover, no serious burden exists in examining at least the claims of the species identified as Species I, II and III at least because the search for the inventions of these groups would be coextensive, or at least significantly overlap. For example, each of the species identified as Species I, II and III requires switching or not switching from a copy mode to a facsimile mode based on input by a panel.

Further, Official Actions on the merits have been issued for the present application on February 3, 2004, November 12, 2004, April 26, 2005 and September 8, 2005, and no restriction or election of species requirement has previously issued. Thus, the Examiner has presumably considered the features of any Species disclosed in the present application, inasmuch as numerous

Official Actions have been issued on the merits to claims directed to such Species.

Thus, no serious burden exists in examining at least the claims of the species identified by the Examiner as Species I, II and III for at least the reason that the search for the inventions of these groups would be coextensive, or at least have significant overlap, and because the Examiner is presumed to have already considered the features of the identified "Species" in one or more of the four previous Official Actions on the merits.

Because any further search of the identified Species would be co-extensive, there would be no serious burden on the Examiner to examine all of the claims in this application. For this reason, consistent with office policy as set forth in MPEP section 803 and section 804, Applicant respectfully requests that the Examiner reconsider and withdraw the election requirement. For the foregoing reasons, the election of species requirement in this application is believed improper and it is respectfully submitted that it be reconsidered and withdrawn.

Further, Applicant submits that Applicant is permitted, even encouraged, by the U.S. Patent and Trademark Office, to draft claims of varying scope. Thus, it is submitted that the Examiner's requirement is improper and should be vacated.

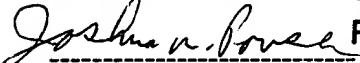
Nevertheless, in order to be fully responsive, Applicant has elected with traverse the invention disclosed in the species identified by the Examiner as

Species I, comprising claims 35-36, 44 and 47-50, in the event that the Examiner chooses not to reconsider and withdraw the Election of Species Requirement.

Should the Examiner have any questions or comments regarding the present paper or this application, the Examiner is respectfully invited to contact the undersigned at the below-listed number.

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